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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,438	12/22/2000	Leandros Kontogouris	BEU/HK/KONTOGOURIS	8890

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BACON & THOMAS, PLLC  
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Alexandria, VA 22314-1176

EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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12/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/742,438

**Applicant(s)**

KONTOGOURIS, LEANDROS

**Examiner**

Arthur Duran

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 6, 8, 9, 12, 13, 15-21, 23, 26, 27 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 8, 9, 12, 13, 15-21, 23, 26, 27, 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1, 5, 6, 8, 9, 12, 13, 15-21, 23, 26, 27, 30-34 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 6/19/08 is not sufficient to overcome the rejection.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 6, 8, 9, 12, 13, 15, 19-21, 23, 26, 27, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Cottingham (6,339,761) in further view of Neel (5,838,314) in view of Griffiths (6,286,045).

Claim 1, 21, 15, 32: Auxier discloses a method, system for ensuring that a user acknowledges an advertisement in exchange for access to an electronic address, service, or content, comprising:  
a computing or communications device of said user, said computing or communications device being connected to a provider of said address, service, or content, over a data communications network (Fig. 1);  
software arranged to be loaded onto said computing or communications device and arranged to participate in presentation of an interactive banner advertisement to the user when said user indicates a desire to access said address, service, or content (col 3, lines 57-61; Fig. 3; col 2, lines 10-20),

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wherein, upon presentation of the interactive banner advertisement, said user is permitted access to an address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Auxier further discloses that when said user indicates a desire to access said address, service, or content via the computer network, causing an advertising server to present an interactive banner advertisement to the user (Fig. 6),

that, upon presentation of the interactive banner advertisement, said user is permitted access to an address, service, or content only if the user submits an appropriate reply to the interactive banner advertisement (col 8, lines 60-65).

Auxier further discloses targeting information and advertising to a specific user (col 3, lines 11-15)

Auxier does not explicitly disclose preventing access to said website, and continuing to prevent said access to said website so long as the user fails to submit the appropriate reply.

However, Cottingham discloses a user requesting a website and, before the requested website is presented to the user, the user being presented advertising for a period of time (col 3, lines 35-44 and col 7, lines 50-58).

And, Neel discloses a user requesting content and, before the content is presented to the user, the user being presented advertising, and the user not being allowed to see the requested content unless the user appropriately answers question(s) or appropriately enters response(s) (Figure 4; Figure 4, item 636; col 18, lines 65-col 19, lines 45; and also, col 5, line 30-40 and col 14, line 50-col 15, line 20).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cottingham and Neel's user requesting a website and then presenting an advertisement and blocking access to a user requested website until the user enters an appropriate reply to Auxier's interactive advertisement that can be placed before the user is given access to a site. One would have been motivated to do this in order to present advertising at a time that will attract attention from the user and to better assure that the user pays attention to advertising.

Also, Examiner notes that Auxier (col 1, lines 15-27) and Cottingham (col 1, lines 35-55) discloses both Internet and radio and television advertising. Hence, it is analogous and obvious that Auxier can incorporate the advertising features of Neel.

Additionally, Auxier discloses that the interactive banner advertisement provides information promoting a product or service (col 6, lines 22-26; col 1, lines 42-47; col 5, lines 35-42).

Auxier discloses that a user requests access to a webpage and that an interactive advertisement can be sent with the webpage data that was requested (Fig. 2).

Auxier further discloses tracking, monitoring, and recording advertisement delivery, interaction, success, etc (col 1, lines 27-60) and that users are targeted (col 3, lines 10-15).

Additionally, Auxier discloses that the user knows what website they will be sent to (Fig. 4, item 410, Advertiser Name) and that a user can be prevented from being

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given access to that requested website if the user does not offer an appropriate reply (col 8, lines 59-64).

Hence, Auxier discloses both sending an interactive advertisement with a webpage request that a user has made and Auxier discloses utilizing an advertisement that requires an appropriate user interaction or reply before a user is allowed to access a requested site (the Advertiser/Merchant site).

Additionally, Auxier discloses that the address, service, or content is provided by a server or broadcaster that is distinct from the advertising server (Fig. 1). Auxier further discloses that said electronic address, service, or content is content provided by a server connected to the Internet (col 1, lines 10-15).

Auxier further discloses that said client software is resident on a server located at or that provides the electronic address, service, or content (Fig. 3; col 2, lines 9-11). Note that regardless of where the client software runs from, the client software is resident on the server before the client software is downloaded from the server to the client.

Auxier further discloses that said client software connects said user's computing device to a server located at or that provides said electronic address, service, or content, and wherein said server carries out said steps of presenting said interactive banner advertisement and permitting access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

Additionally, Auxier discloses an interactive banner advertisement and permitting access to said service only if the user submits an appropriate reply to the banner advertisement as disclosed in the independent claim.

Auxier does not explicitly disclose that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement.

However, Griffiths discloses banner advertisements (col 3, lines 13-21). Griffiths further discloses that said client software connects said user's computing device to a proxy server, and wherein said proxy server carries out said steps of presenting said interactive banner advertisement (Fig. 1; Fig. 3; col 4, lines 17-29). Griffiths further discloses taking measures for more efficient delivery of advertising over a network (col 1, lines 9-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Griffiths utilization of proxy servers with banner advertisements to Auxier's banner advertisements delivered over a network. One would have been motivated to do this for more efficient deliver of advertising over a network.

Claims 15, 32: Please see the rejection of claim 1 above. Also, Auxier does not explicitly disclose a subscription service where the user is provided the content of interest without advertising is the user is a subscriber but the user is provided advertising if the user is not a subscriber. However, Neel discloses that the user can register (col 19, lines 30-35). And, Neel discloses the steps of identifying said user and determining whether said user has agreed to the ad service, and wherein said step of

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presenting said interactive banner advertisement is carried out if said user has not agreed to the ad service (col 17, line 45-col 18, line 10; Figure 4). And, Cottinham discloses a registration service where the user registers and pays regularly for a service (the ISP service) and also that a variety of content can be presented to the user (col 1, 35-col 2, line 67). Auxier does not explicitly disclose that there can be a subscription to the content. However, since Cottinham discloses registering and paying regularly for service and also a presenting a wide variety of content, it is obvious that the content or website that the user can access can be through. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Neel's user deciding whether or not to allow the advertiser to sponsor the content and a subscription service to Auxier's providing content and advertisements. One would have been motivated to do this in order to better provide an option to attract customers who do not like advertising.

Alternatively, please see the additional rejection of claims 15 and 32 below with Cook to address a subscription service.

Claim 5, 6, 12, 13, 20, 23, 30, 31:

The prior art discloses the above.

Auxier discloses television and the Internet (col 1, lines 10-15; col 1, lines 17-21).

Auxier does not explicitly disclose that said electronic address, service, or content provided by a broadcaster on an interactive digital television network.

Auxier does not explicitly disclose a cellular or wireless network.



However, Neel discloses that said electronic address, service, or content provided by a broadcaster on an interactive digital television network (Abstract).

Neel further discloses a wireless network and a cellular network (Abstract).

Neel further discloses that said electronic address, service, or content is a subscription-based service (col 23, lines 15-25).

And, Examiner takes Official Notice that the utilization of cookies and plug-ins related to Internet browsers were common, old, obvious, and well-known techniques at the time of the Applicant's invention.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add interactive television, cellular, wireless network, and cookies to Auxier's Internet and television. One would have been motivated to do this because interactive television is an obvious device that combines the Internet and television and would appeal to many users and the Internet is obviously manifested on different types of network for the convenience of the user and cookies are a standard and convenient way to store information on a user's device. Furthermore, plug-ins are standard Internet software tools and a subscription service is a standard and convenient way for a user to receive information.

Claim 8, 26: The prior art discloses a method as claimed in claim 7, and Auxier further discloses that a provider of the electronic address, service, or content downloads said client software to the user's computing device when said user requests access to said electronic address, service, or content (Fig. 3; col 2, lines 10-20).

Claim 9, 27: The prior art discloses a method as claimed in claim 8. Auxier further discloses that said client software is resident on said user's computing device before said user requests access to said electronic address, service, or content (col 4, lines 43-53; col 2, lines 10-15). Auxier further discloses the reception of special code that allows banner advertisements to be interacted with (col 4, lines 43-53) and that the special code can be stored on the client computer (col 2, lines 10-15). Therefore, Auxier implies that the special code can reside on the client computer before future requests for the user will make.

Claim 19: The prior art discloses a method as claimed in claim 14.

Auxier further discloses targeting advertisements to the user (col 3, lines 10-13).

Auxier further discloses collecting user provided information (col 2, lines 39-42; col 7, lines 17-23).

Auxier does not explicitly disclose that said interactive banner advertisements are selected based on information stored on said user's computing device and information provided by said user.

However, Cottingham further discloses that said interactive banner advertisements are selected based on information stored on said user's computing device and information provided by said user (Abstract).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add different information depending on the type of user to Auxier's targeted user. One would have been motivated to do this because

targeting a user implies sending that user different information depending upon who the user is and also in order to better target the user.

Claims 15, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Cottingham (6,339,761) in view of Neel (5,838,314) in view of Griffiths (6,286,045) in view of Cook (6,338,044)

Claims 15, 32: Please see the rejection of claim 1 above. Also, Auxier does not explicitly disclose a subscription service where the user is provided the content of interest without advertising is the user is a subscriber but the user is provided advertising if the user is not a subscriber. However, Neel discloses that the user can register (col 19, lines 30-35). And, Neel discloses the steps of identifying said user and determining whether said user has agreed to the ad service, and wherein said step of presenting said interactive banner advertisement is carried out if said user has not agreed to the pay for the content service (col 17, line 45-col 18, line 10; Figure 4). And, Cottingham discloses a registration service where the user registers and pays regularly for a service (the ISP service) and also that a variety of content can be presented to the user (col 1, 35-col 2, line 67). Auxier does not explicitly disclose that there can be a subscription to the content. However, Cook discloses a subscription service where the user is provided the content of interest without advertising is the user is a subscriber but the user is provided advertising if the user is not a subscriber (col 7, lines 1-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Neel's user deciding whether or not to allow

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the advertiser to sponsor the content and Cook's user being able to subscribe so they do not receive advertisements to Auxier's providing content and advertisements. One would have been motivated to do this in order to better provide an option to attract customers who do not like advertising.

4. Claim 16-18, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auxier (6,379,251) in view of Cottingham (6,339,761) in view of Neel (5,838,314) in view of Griffiths (6,286,045) in view of Eggleston (6,061,660).

Claim 16-18, 33, 34: The prior art disclose a method as claimed above.

Also, Auxier further discloses targeting a user and that a user can be a repeat user (col 3, lines 10-14; col 4, lines 45-54). Auxier further discloses that the user can win (col 6, lines 25-30). Auxier further discloses that the user can win prizes in the form of the merchants services (col 6, lines 25-30).

Also, as disclosed above, Cottingham and Neel disclose that the user have accounts and are registered.

Auxier does not explicitly disclose tallying credits.

However, Eggleston discloses tallying credits so that a user can receive a prize (col 13, lines 50-67) including the services of a merchant (col 1, lines 33-35; col 13, lines 60-62) and that the credits are tallied in response to a correct answer (col 26, lines 53-58; col 7, lines 45-50) and that the user has an account with credits in it (col 16, lines 54-56). Eggleston further discloses that a user can be awarded for watching advertising (col 1, lines 37-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's tallying of points won and that the credits won can be used to pay for a variety of goods/services to Auxier's targeted user and receiving merchant services as a prize for correct answers. One would have been motivated to do this because tallying award totals allows tracking the user for better targeting over the longer term.

### ***Response to Arguments***

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the grounds of rejection above. The same prior art has been used but the prior art combinations have been adjusted to address the modified claims. Also, Cook was added as an alternative to address the subscription features. Also, Examiner notes the following.

Also, the 37 CFR 1.131 has been considered. In order to further prosecution, the Examiner has changed the rejection above to utilize prior art that replaces the Hamzy reference. However, Examiner reserves the right to readdress the Hamzy reference as valid prior art in light of the 37 CFR 1.131 in the future.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

And, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Teaching of a preference does not constitute a teaching away from the proposed combination under review. See *In re Fulton*, 391 F.3d 1195, 1199-1200, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Additionally, in the MPEP section 716.01(c) under the title “Attorney Arguments Cannot Take the Place of Evidence”, note that objective evidence must be presented to prove inoperability.

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And, it is the combination that renders obvious the features of the Applicant's claims. For example, Auxier (col 1, lines 15-27) and Cottingham (col 1, lines 35-55) discloses both Internet and radio and television advertising. Hence, while Neel discloses advertising in a television environment, Neel is analogous with Auxier and Cottingham. And, it would be obvious to one skilled in the art that Auxier can incorporate some of the advertising features of Neel into the Internet environment of Auxier.

Also, on page of the Applicant's Remarks dated 4/28/2008, Applicant states that Neel does not disclose opting out based on a subscription. However, Neel discloses that the user can pay for content and opt out of the advertising (see rejection above). And, the prior art combination Or Cook render obvious a subscription service.

On page 10, Applicant states that the proxy server in Griffiths does not serve the ads. However, the proxy server in Griffiths serves ads (Fig. 3, items 85, item 100, "server and store banner from proxy server", item 84, "server and store page from proxy server").

On page 13, Applicant states that the Griffiths does not disclose the client going to the proxy server then to the website. However, Auxier discloses using Java applets (see above) and Griffiths discloses a terminal making a request for a page and then a proxy server providing the page and ads back to the terminal (Fig. 3).

Also, please see the rejections above.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

A) Goldhaber and Angles discloses tallying points/awards/credits to pay for services provided to a user;

b) de Boor (US007228340B2) discloses blocking presenting requested content til the user responds to an ad presented.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran  
Primary Examiner  
Art Unit 3622

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Primary Examiner, Art Unit 3622  
12/9/2008